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10/519,536	12/28/2004	Yoshikatsu Kodama	2004_2037A	2533
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EXAMINER				
TONGUE, LAKIA J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,536

Applicant(s)

KODAMA ET AL.

Examiner

LAKIA J. TONGUE

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 17, 2008 has been entered.

Applicant's response filed on January 17, 2008 is acknowledged. Claims 1-6 and 19 are pending. Claims 2-5 have been amended. Claims 7-11, 14 and 16-18 have been canceled. Claim 19 has been added and withdrawn from consideration. Claims 1-6 are currently under examination.

Rejections Withdrawn

1. In view of Applicant's amendment and arguments the rejection of claims 2-7 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is withdrawn.

Rejections Maintained

2. The rejection claims 2-7 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement because the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention is maintained for the reasons set forth in the previous Office action.

Applicant argues that:

1) Claims 2 and 6 have been amended to clarify that the soluble outer membrane protein is the soluble protein F3.

2) Applicants' have attached a Declaration under 37 CFR 1.132 by Dr. Kodama that further demonstrates that the claimed composition is capable of inducing protective immunity against chicken coccidiosis.

Applicant's arguments have been considered, but have not been deemed persuasive.

The claims are drawn to an anti-chicken coccidiosis composition for oral administration, comprising an antibody obtained from an egg of a chicken immunized with the soluble outer membrane protein F3 from the merozoite of *Eimeria acervulina*, which is a fraction of soluble outer membrane proteins of 18 to 27 KD and has a common immunogenicity shared among sporozoite and merozoite of *Eimeria acervulina*, *Eimeria tenella* and *Eimeria maxima* which are associated with chicken coccidiosis, and a lactic acid bacterium.

With regard to Points 1 and 2, while Applicant has amended the claims to recite "soluble outer membrane protein F3 from the merozoite of *Eimeria acervulina*, which is a fraction of soluble outer membrane proteins of 18 to 27 kD" and has submitted a revised Declaration by Dr. Kodama, the instant claims are drawn to the soluble outer membrane protein wherein the soluble protein is F3 from the merozoite of *Eimeria acervulina*, which is a fraction of soluble outer membrane proteins of 18 to 27 kD. The claims as amended recite the soluble outer membrane protein wherein the soluble protein is F3 from the merozoite of *Eimeria acervulina*, which is a fraction of soluble outer membrane proteins of 18 to 27 kD. Consequently, it is unclear how a single protein (i.e. F3) can be a fraction of proteins from 18 to 27 kD. The letter "s (proteins)" coupled with the range of 18 to 27 kD implies that there is more than one protein or fraction of soluble outer membrane proteins to choose from and that the F3 protein is not the only protein being claimed and/or described.

Moreover, Applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. Although Applicant has amended the claims, they are not drawn to a specific antibody (i.e. defined) with the claimed specificity. Moreover, the specification does not fully characterize the antigen used to immunize (i.e. a soluble outer membrane protein of 18 to 27 kD from the merozoite of *Eimeria acervulina* outer membrane protein).

The courts have recently decided in *Randolph J. Noelle v Seth Lederman, Leonard Chess and Michael J. Yellin* (CAFC, 02-1187, 1/20/2004) that a patentee of a biotechnological invention cannot necessarily claim a genus after only describing a

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limited number of species because there may be unpredictability in the results obtained from species other than those specifically enumerated. See Enzo Biochem II, 323 F.3d at 965; Regents, 119 F.3d at 1568. Therefore, based on our past precedent, as long as an applicant has disclosed a "fully characterized antigen," either by its structure, formula, chemical name, or physical properties, or by depositing the protein in a public depository, the applicant can then claim an antibody by its binding affinity to that described antigen. Noelle did not provide sufficient support for the claims to the human CD40CR antibody in his '480 application because Noelle failed to disclose the structural elements of human CD40CR antibody or antigen in his earlier '799 application. Noelle argues that because antibodies are defined by their binding affinity to antigens, not their physical structure, he sufficiently described human CD40CR antibody by stating that it binds to human CD40CR antigen. Noelle cites Enzo Biochem II for this proposition. This argument fails, however, because Noelle did not sufficiently describe the human CD40CR antigen at the time of the filing of the '799 patent application. In fact, Noelle only described the mouse antigen when he claimed the mouse, human, and genus forms of CD40CR antibodies by citing to the ATCC number of the hybridoma secreting the mouse CD40CR antibody. If Noelle had sufficiently described the human form of CD40CR antigen, he could have claimed its antibody by simply stating its binding affinity for the "fully characterized" antigen. Noelle did not describe human CD40CR antigen. Therefore, Noelle attempted to define an unknown by its binding affinity to another unknown. As a result, Noelle's claims to human forms of CD40CR antibody found in his '480 application cannot gain the benefit of the earlier filing date of his '799

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patent application.

Moreover, defining epitopes is not an easy task, as evidenced by Greenspan et al. (Nature Biotechnology 17: 936-937, 1999). Greenspan et al. recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody necessary to define an "epitope" (page 937, column 2). According to Greenspan et al., an epitope will include residues that make contacts with a ligand, here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might profoundly affect binding. Accordingly, it follows the epitope to which any given antibody binds can only be identified empirically. Even using a competition assay, the skilled artisan cannot determine whether an antibody binds the same epitope as another antibody because an antibody that competes with another does not necessarily bind the same epitope as the other; rather, one antibody may bind a spatially overlapping epitope to sterically hinder binding of the other. Therefore, absent a detailed and particular description of a representative number, or at least a substantial number of the members of the genus of epitopes to which the members of the claimed genus of antibodies must bind, the skilled artisan could not immediately recognize or distinguish members of the claimed genus of antibodies. Moreover, since the specification has not identified which amino acids of the genus of epitopes to which the members of the claimed genus of antibodies must bind, which are critical or essential to the binding, one skilled in the art would not

recognize that Applicant had possession of the claimed invention at the time the application was filed.

As previously presented, claims 2-7 are drawn to a vast genus of antigenic outer membrane proteins and immunogenic fragments thereof. To fulfill the written description requirements set forth under 35 USC § 112, first paragraph, the specification must describe at least a substantial number of the members of the claimed genus, or alternatively describe a representative member of the claimed genus, which shares a particularly defining feature common to at least a substantial number of the members of the claimed genus, which would enable the skilled artisan to immediately recognize and distinguish its members from others, so as to reasonably convey to the skilled artisan that Applicant has possession the claimed invention.

Moreover, the skilled artisan cannot envision the detailed structure of the encompassed proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The polypeptide itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404. 1405 held that: "...To fulfill the written description requirement, a patent specification must

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describe an invention and does so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of the claimed antigenic outer membrane protein or an immunogenic fragment thereof, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993).

However, the specification has not provided an adequate showing of which antibodies bind to antigens based solely on their common immunogenicity from among different species. The specification does not provide a written description of the invention of claims 2-7. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she

was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed.

Therefore, absent a detailed and particular description of a representative number, or at least a substantial number of the members of the genus of antigenic outer membrane protein or an immunogenic fragment thereof, the skilled artisan could not immediately recognize or distinguish members of the claimed genus having preventive and/or reduced cellular and humoral immunogenicity. Therefore, because the art is unpredictable, in accordance with the Guidelines, the description of antigenic outer membrane protein or an immunogenic fragment thereof, is not deemed representative of the genus of immunogenic compositions to which the claims refer and hence do not meet the written description requirements.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The rejection of claims 2 and 4 under 35 U.S.C. 103(a) as being unpatentable over Lillehoj et al. (Avian Diseases, 2000; 44: 379-389) further in view of Wells et al. (Antonie van Leeuwenhoek, 1996; 70: 317-339) is maintained for the reasons set forth in the previous office action. Applicant's argument as it pertains to claim 6 obviates the rejection of said claim.

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Applicant argues that:

1) Lillehoj et al. only disclose oral immunization of chicken with the F3 protein itself.

2) One of ordinary skill in the art would reasonably conclude that the state of the art was such that passive immunity would not be an effective treatment for avian coccidiosis (i.e. page 1616, 1st column, 1st paragraph).

Applicant's arguments have been considered, but have not been deemed persuasive.

The claims are drawn to an anti-chicken coccidiosis composition for oral administration, comprising an antibody obtained from an egg of a chicken immunized with the soluble outer membrane protein F3 from the merozoite of *Eimeria acervulina*, which is a fraction of soluble outer membrane proteins of 18 to 27 KD and has a common immunogenicity shared among sporozoite and merozoite of *Eimeria acervulina*, *Eimeria tenella* and *Eimeria maxima* which are associated with chicken coccidiosis, and a lactic acid bacterium.

With regard to Point 1, contrary to Applicant's argument, the protein necessarily has the antibody because it was obtained in the same way as the claimed composition.

With regard to Point 2, the instant claims are drawn to a composition. Applicant's arguments are not relevant because a limitation such as "treatment for avian coccidiosis" is viewed as a limitation of intended use. Moreover, page 1616, 1st column, 1st paragraph is not convincing as it has nothing to do with passive immunity. Additionally, Applicant's argument regarding the 1987 reference, which discloses that

"one would reasonably conclude that the state of the art was such that passive immunity would not be effective treatment for avian coccidiosis" implies that the invention is not enabled.

As previously presented, Lillehoj et al. disclose an anti-chicken coccidiosis composition for oral administration to prevent chicken coccidiosis, comprising an antibody obtained from an egg of a chicken immunized with a soluble outer membrane of 18 to 27 kD from the merozoite of *Eimeria acervulina*, wherein the soluble membrane protein is the soluble protein F3 (see abstract). Lillehoj et al. disclose that chickens were immunized orally with said protein (see page 385). Moreover, Lillehoj et al. disclose that recombinant antigens expressed by different vector systems conferred different levels of immunity (see page 388).

Lillehoj et al. does not specifically disclose a lactic acid bacterium.

Wells et al. disclose the use of lactic acid bacteria as vaccine delivery vehicles. Moreover, Wells et al. disclose that the efficacy of bacterial vectors as vaccines is believed to depend on their invasiveness, capacity to survive and multiple, and on the occurrence of adequate levels of antigen gene expressions *in vivo* (see page 318).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the invention of Lillehoj et al. by combining a lactic acid bacteria to the claimed composition to simplify vaccine distribution and vaccine administration as well as provide a safe, effective vaccine that is capable of eliciting active immunity (see page 317-introduction). One would have had a reasonable expectation, barring

evidence to the contrary, that the composition and method would be effective for the prevention or treatment of chicken coccidiosis.

New Grounds of Objection/Rejection

Claim Objections

4. Claim 2 is objected to because of the following informalities: The word "acervulinau" should be spelled "acervulina". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 6 are rendered vague and indefinite by the use of the term "immunogenicity". It is unclear what is meant by said term, as it is not explicitly defined in the specification. What constitutes a "immunogenicity"? Is it the ability of an immunogen to induce an immune response and if so what is the commonality amongst the strains, the amount of immune response, the type of immune response, or is it a particular response against a particular antigen? As written, it is impossible to determine the metes and bounds of the claimed invention.

Claims 2 and 6 are rendered vague and indefinite by the use of the phrase "the soluble outer membrane protein F3 from the merozoite of *Eimeria acervulina*", which is a

fraction of soluble outer membrane proteins of 18 to 27 KD". It is unclear what is meant by said phrase, as it is not explicitly defined in the specification. What constitutes "18 to 27 KD"? Is it the soluble outer membrane protein F3 or a fraction of soluble outer membrane proteins of F3? As written, it is impossible to determine the metes and bounds of the claimed invention.

Claims 2 and 6 are rendered vague and indefinite by the use of the term "F3". The designation "F3" constitutes a laboratory designation that does not provide any structural or functional limitations. As written, it is impossible to determine the metes and bounds of the claimed invention.

Conclusion

6. No claim is allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakia J. Tongue whose telephone number is 571-272-2921. The examiner can normally be reached on Monday-Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on 571-272-0898. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LJT
2/26/08

/Robert A. Zeman/

for Lakia J. Tongue, Examiner of Art Unit 1645